

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*AS*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/436,360	11/09/99	SANDERSON	A PM244889/98

PILLSBURY MADISON & SUTRO LLP  
INTELLECTUAL PROPERTY GROUP  
NINTH FLOOR EAST TOWER  
1100 NEW YORK AVENUE NW  
WASHINGTON DC 20005-3918

IM22/0305

EXAMINER

SERGENT, R

ART UNIT	PAPER NUMBER
1711	12

DATE MAILED:

03/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/436,360</b>	Applicant(s) <b>Sanderson et al.</b>
	Examiner <b>Rabon Sergent</b>	Group Art Unit <b>1711</b>

Responsive to communication(s) filed on Nov 2, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) 14-40 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-13 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 3,9

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1711

1. Applicant's election of Group I, claims 1-13 in Paper No. 11, filed November 2, 2000, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 09/436,440. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to polyisocyanate based elastomers derived from equivalent reactants.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1711

4. Claims 1-13 are directed to an invention not patentably distinct from claims 1-11 of commonly assigned 09/436,440. Specifically, each set of claims is drawn to elastomers derived from equivalent reactants.

5. Commonly assigned 09/436,440, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

6. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language, "below about 75<sup>0</sup>C", "above about -20<sup>0</sup>C", and "below about 60<sup>0</sup>C", renders the claims indefinite, because "about" encompasses values slightly above or below the

Art Unit: 1711

recited values; therefore it is unclear if the language is met by values of 75<sup>0</sup>C or higher, -20<sup>0</sup>C or lower, and 60<sup>0</sup>C or higher, respectively.

7. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to define what is meant by "substantially solid".

8. Claims 2 and 3 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for elastomers produced from 2,4-toluene diisocyanate, does not reasonably provide enablement for elastomers produced from generic toluene diisocyanate, which includes 2,6-toluene diisocyanate. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Applicants have failed to demonstrate that 2,6-toluene diisocyanate possesses the necessary hindrance to function within the invention, as claimed.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

Art Unit: 1711

commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wardle ('613) in view of Biddle et al. ('794) and Hinshaw et al. ('603).

Wardle discloses the production of polyurethane elastomers wherein the polymer comprises hard and soft segments linked by the reaction of the isocyanate reactive A segment and B segment with diisocyanates and linking compounds. Patentee further discloses the use of 2,4-toluene diisocyanate as a suitable asymmetric diisocyanate. See abstract and columns 4-9.

11. While Wardle discloses hard segments which meet those claimed by applicants, patentee fails to disclose the specific use of an oxirane-based soft segment, though patentee further fails to specifically limit the compound by species. However, the position is taken that the use of oxirane-based polymers was known to be useful for incorporating soft segments within hard segment/soft segment thermoplastic elastomers at the time of invention. Biddle et al. disclose at column 6 the use of polyglycidyl azide and polyglycidyl nitrate as soft blocks within such polymers. Furthermore, Hinshaw et al. disclose at column 1, lines 57 and 58 that such soft blocks contain secondary hydroxyl groups.

Art Unit: 1711

12. Therefore, in view of the teachings of the secondary references, it would have been obvious to utilize an oxirane-based segment as the soft segment of Wardle, so as to arrive at the instant invention.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

  
**RABON SERGENT**  
**PRIMARY EXAMINER**

Sergent/af

January 29, 2001